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09/937,708	12/31/2001	Knut Adams	1454.1102	7003

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EXAMINER

MANCHO, RONNIE M

ART UNIT PAPER NUMBER

3663

DATE MAILED: 04/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/937,708

Applicant(s)

ADAMS ET AL.

Examiner

Ronnie Mancho

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 16-25,27-30,32 and 33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 16-25,27-30,32 and 33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 32, 33 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In claim 32, the applicant recites “wherein the control signals issued by said control and monitoring system relate to at least *one of powering and movement* of the device. It can be understood that applicant’s invention (sec. 0023) has a GPS unit that monitors the movement of the device or vehicle. On the other hand, there was no disclosure that the control signals issued by said control and monitoring system relate to *powering* of the device or vehicle. In the last few lines of applicant’s specification, section 0026 recites “The corresponding rules DR for this short-term monitoring are thus chosen such that the recording of the data signals by means of the recording unit DA takes place only in a (Generator of the supply voltage source in the vehicle in operation) operating mode, or only in an (ignition ON) operating mode. This ensures that the battery voltage of the vehicle in which the data acquisition apparatus MC is arranged is not loaded unnecessarily”. This indicates that data is recorded or acquired when a supply voltage of a generator is on, or when a vehicle ignition is on. Thus there is no disclosure that the control

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signals issued by said control and monitoring system relate to *powering* of the device or vehicle as claimed.

In claim 33, the applicant claims “power train”. Nowhere in the disclosure is the claimed “Power train” recited. Power train could imply a transmission, a battery of hybrid vehicle, etc,

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 16-25, 27-30, 32, 33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. In claim 16, the applicant recites, “a control and monitoring system directly controlling operational states of the device *in which said apparatus is mounted*.” The metes and bounds of the limitation are not ascertained. The applicant needs to clarify if --said apparatus is mounted in the control and monitoring system or not--. It is noted that applicant already mentioned “an apparatus for data acquisition of a device *on which the apparatus is mounted*”.

### ***Claim Objections***

6. Claim 16 is objected to because of the following informalities. In claim 16, the applicant claims “an apparatus for data acquisition of a device”. The limitation indicates does not make grammatical sense in reference to “data acquisition of a device”. Applicant’s disclosure does not teach acquiring a device. It is believed that applicant meant to recite -- an apparatus for acquiring data from a device--. Therefore the limitation will be interpreted as such. Applicant is thus called upon to make the necessary correction.

Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

8. Claims 16-25, 27-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Westerlage et al (6295449)

Regarding claim 16, Westerlage et al (figs. 5-12) disclose an apparatus (216, figs. 5&7) for acquiring data from a device (vehicle 212, figs. 5-8; col. 22, lines 25-41), the apparatus (216, figs. 5&7) mounted on the device (vehicle 212, col. 14, lines 14-17) for transmission of the acquired data to a control center (226, 228, 224; fig. 5), the apparatus (216) comprising:

a control and monitoring system (system 244, 246, 256, 258, 259, fig. 7; col. 22, lines 31-60) directly controlling (delivery or destination instructions; col. 18, lines 8-18; i.e. central host

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thru apparatus 216 coordinates activities of vehicles or trucks, col. 20, lines 49-52) operational states (col. 16, lines 62-67; col. 18, lines 1-18) of a the device (vehicle 212; col. 22, lines 31-36, lines 57-60), wherein the apparatus 216 is mounted on the device (vehicle 212; col. 14, lines 14-17) via control signals (i.e. sensors of apparatus 216 are connected to the vehicle 212 via signals to collect performance data of vehicle 212, col. 16, lines 62-67);

at least one input interface (240, 266, 272-276, etc; fig. 7) for supplying input signals;

a transmitting/receiving unit 238 (fig. 7);

a signal processing apparatus 246 (col. 16, lines 25-45) coupled to the input interface (240, 266, 272-276, etc; fig. 7) for signal processing of the input signals to derive output data in accordance with a first set of predetermined rules, said signal processing unit 246 including a data analysis unit to record (col. 16, lines 25-45) selected input signals at predetermined times in accordance with recording rules defined in advance by the control center (226, 228, 224; figs. 5, 8, col. 16, lines 20-38) for short-term monitoring of information derived from the input signals; and

an output interface 216 (col. 7, lines 53-65; col. 16, lines 25-45), coupled to the signal processing unit 246, for supplying the output data (see wireless link, figs. 5-7) from said signal processing unit 246 to said transmitting/receiving unit 218 (figs. 5&6) for at least one of automatic transmission or transmission initiated on request.

Regarding claim 17, Westerlage et al (figs. 5-12) disclose the apparatus as claimed in claim 16, further comprising at least one writeable memory for storage of an operating system for the apparatus and the recording rules remotely loaded via the transmitting/receiving unit.

Regarding claim 18, Westerlage et al (figs. 5-12) disclose the apparatus as claimed in claim 16, characterized in that the apparatus has a data converter, which is arranged between the input interface and the signal processing unit and which is used for removing distortion from the supplied input signals and for providing a standard data format for the input signals.

Regarding claim 19, Westerlage et al (figs. 5-12) disclose the apparatus as claimed in claim 18, characterized in that the apparatus has an address allocation unit, which is provided between the data converter and the input interface, and is intended for conversion of a source-specific addresses of the input signals to the address format of the data converter.

Regarding claim 20, Westerlage et al (figs. 5-12) disclose the apparatus as claimed in claim 16, wherein the apparatus is installed in a mobile vehicle which is operated by a motor or engine, and has a generator of a supply voltage, and

wherein the apparatus further comprises:

a power supply connection (figs. 1&7) coupled to the generator of the supply voltage in the vehicle, said transmitting/receiving unit and said signal processing unit; and

a detection unit, coupled to said power supply connection and to said data analysis unit, to detect at least whether the generator of the supply voltage source is in operation, and to interrupt said data analysis unit when the generator of the supply voltage source is not in operation.

Regarding claim 21, Westerlage et al (figs. 5-12) disclose the apparatus as claimed in claim 20 further comprising a memory, coupled to the signal processing unit, to store a second set of predetermined rules, and wherein said signal processing unit further comprises a data

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processing unit to record information data derived from the input signals in accordance with the second set of predetermined rules.

Regarding claim 22 (as best understood), Westerlage et al (figs. 5-12) disclose the apparatus as claimed in claim 21, wherein said memory further comprises a first memory area containing predetermined rules for keeping the supply voltage source in operating mode, and a second memory area containing predetermined rules for not keeping the supply voltage source in operating mode.

Regarding claim 23, Westerlage et al (figs. 5-12) disclose the apparatus as claimed in claim 21, wherein the signal processing apparatus has an alarm unit, coupled to said memory and to said data processing unit, for monitoring information data derived from the input signals in accordance with predetermined alarm rules, and wherein the apparatus further comprises a memory to store predetermined rules for the alarm unit.

Regarding claim 24, Westerlage et al (figs. 5-12) disclose the apparatus as claimed in claim 23, characterized in that the apparatus has an alarm archive for storing information on alarms that have occurred.

Regarding claim 25 Westerlage et al (figs. 5-12) disclose the apparatus as claimed in claim 21, characterized in that the signal processing unit includes a monitoring unit, coupled to said at least one input interface, for monitoring of the input signals and the information data.

Regarding claim 27, Westerlage et al (figs. 5-12) disclose the apparatus as claimed in claim 16 further comprising a GPS interface to connect the apparatus to a GPS receiver.

Regarding claim 28, Westerlage et al (figs. 5-12) disclose the apparatus as claimed in claim 16, wherein the input signals are operating data relating to one of a vehicle and a machine.



Regarding claim 29, Westerlage et al (figs. 5-12) disclose the apparatus as claimed in claim 28; characterized in that the apparatus is integrated in a car radio receiver and in a car radio receiver/mobile telephone appliance.

Regarding claim 30, Westerlage et al (figs. 5-12) disclose the apparatus as claimed in claim 16, wherein said transmitting/receiving unit transmits the output data to at least one of the control center and a predetermined receiver.

Regarding claim 32, Westerlage et al (figs. 5-12) disclose the apparatus as claimed in claim 16, wherein the control signals issued by said control and monitoring system relate to at least one of powering and movement (col. 8, lines 18-29; col. 17, lines 51-63) of the device (vehicle, fig. 5) in which said apparatus is mounted.

Regarding claim 33, Westerlage et al (figs. 5-12) disclose the apparatus as claimed in claim 31, wherein the device is a vehicle (figs. 5, etc) having a powertrain, and wherein the output data includes conditions of the powertrain (see diagnostics of subsystem, col. 7, lines 9-12; col. 8, lines 18-29; col. 17, lines 51-63; col. 20, lines 29- 40).

9. The statements of intended use or field of use, "for transmission to", "directly controlling", "to supply", "to perform", "to record .....at predetermined times", "to remove", etc clauses are essentially method limitations or statements of intended or desired use. Thus, these claims as well as other statements of intended use do not serve to patentably distinguish the claimed structure over that of the reference. See *In re Pearson*, 181 USPQ 641; *In re Yanush*, 177 USPQ 705; *In re Finsterwalder*, 168 USPQ 530; *In re Casey*, 512 USPQ 235; *In re Otto*, 136 USPQ 458; *Ex parte Masham*, 2 USPQ 2nd 1647.

See MPEP § 2114 which states:

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A claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ 2nd 1647

Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than functions. In re Danly, 120 USPQ 528, 531

Apparatus claims cover what a device is not what a device does. Hewlett-Packard Co. v. Bausch & Lomb Inc., 15 USPQ2d 1525, 1528.

As set forth in MPEP § 2115, a recitation in a claim to the material or article worked upon does not serve to limit an apparatus claim.

### ***Response to Arguments***

10. Applicant's arguments filed 2-2-06 have been fully considered but they are not all persuasive.

The applicant is arguing that the prior art, Westerlage et al do not disclose “a control and monitoring system” as claimed.

In response, the argument is traversed. Westerlage et al disclose a control and monitoring system (system 244, 246, 256, 258, 259, fig. 7; col. 22, lines 31-60) directly controlling (delivery or destination instructions; col. 18, lines 8-18; i.e. central host thru apparatus 216 coordinates activities of vehicles or trucks, col. 20, lines 49-52) operational states (col. 16, lines 62-67; col. 18, lines 1-18) of a the device (vehicle 212; col. 22, lines 31-36, lines 57-60), wherein the apparatus 216 is mounted on the device (vehicle 212; col. 14, lines 14-17) via control signals (i.e.

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sensors of apparatus 216 are connected to the vehicle 212 via signals to collect performance data of vehicle 212, col. 16, lines 62-67).

The rejection is believed to be proper and stands

### ***Conclusion***

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

### ***Communication***

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ronnie Mancho whose telephone number is 571-272-6984. The examiner can normally be reached on Mon-Thurs: 9-5.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Keith can be reached on 571-272-6878. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

4/15/06

  
JACK KEITH  
SUPERVISORY PATENT EXAMINER